UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>28 August 2009</u>.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>124-135</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>124-135</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments with respect to **claims 124-135** have been considered but are moot in view of the new ground(s) of rejection based on the currently amended claims and because Applicant has deleted the sections of the claims discussed in the arguments.

2.   Based on the current amendments the objections have been withdrawn.

3.   The 35 USC 101 rejection is applied below.

4.   The discussion regarding the 112 paragraphs 1 and 2 rejections and the current amendments are acknowledged. Therefore, the previous rejections have been withdrawn however new 112 paragraph 2 rejections are applied below.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6.   **Claims 124-127 and 132-134** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7.   **Claims 124-127** teach a "digital processing device", however it remains if the device disclosed works in a digital format. The Appendix to the Specification notes that with the Documentation Tool disclosed there is no mention of whether the system is

digital and as a result it could be interpreted as an analog process. The analog process in turn would depend on manual and not automated entries from a human evaluator.

Furthermore, the notification of the system being "auditable" gives the appearance that the system might be electronically auditable using a data storage device rather than manually auditable via a review by in-house and outside counsel, for example. However, like the auditing step it appears that the human evaluator is associating the information and manually entering the information noted however this is not clear in the claims.

8.   **Claims 132-134** teach that the data storage device "upon execution by the digital computer" performs "the steps of receiving a first rating...receiving the second rating" etc. The specification as written implies that the process of receiving is manual input of data and not automatic electronic entry as is implied by the claims. The claims as written are confusing. Page 8 of the Appendix states "employee data - data entered into Trade Secret Examiner"; "Trade secret management data - data entered into the Trade Secret Examiner"; "Trade secret data - data entered into the Trade Secret Examiner". All these excerpts imply the data is entered manually and not electronically. Therefore the claims as written are indefinite.

Claim Rejections - 35 USC § 101

9.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10.   **Claims 125-127 and 135** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

11.   In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials). *In re Bilski*, 545 F. 3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to claims 124-127, the claim language does not include the required tie or transformation and thus is directed to nonstatutory subject matter. These claims teach step which can still be interpreted as being done by a human being. For example, in claim 125, Applicant states comparing calculation and determining it the calculated trade secret exceeds a threshold without the inclusion of the machine used to carry out this step. Claim 126 teaches the step of "repeating" which lacks clarity because it remains uncertain what is done to repeat and what machine is used. Therefore, these claim are not statutory.

Claim Rejections - 35 USC § 103

12.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13.   **Claims 124-135** are rejected under 35 U.S.C. 102(e) as anticipated by or, in the

alternative, under 35 U.S.C. 103(a) as obvious over **martin** in view of **Barney et al. (US**

6,556,992 B1) (hereinafter "**Barney**") and further in view of **court case**.

14.   **With respect to claims 1-123 (canceled)**.

    ○   **With respect to claims 124 and 128:** (currently amended)   Martin

        teaches:

        ○   Executing instructions relating to the auditable accounting system

            in a digital processing device, to determine at least one metric;

            (Martin: col. 5, lines 1-67 – "the expert system performs data

            management and actuarial modeling"; detailed analyses performed

            of organizational, legal and financial structure of the applicant and

            its collateral to determine whether qualified for asset analysis; IP

            value assessment; CPU)

        ○   receiving in the digital processing device information corresponding

            to the first through sixth rating; (Martin: col. 5, lines 1-67 –

            information received relates to data collected from the applicant

            and/or other sources such as answers to questionnaires prepared

            by the user in advance, direct input of documents containing the

            information and data retrieved from external sources)

Martin does not teach, however Applicant admits in the Background of the in

Invention that trade secret is a form of intellectual property.   (Applicant's Admission:

Background of the Invention, pages 1 and 3 – "Trade secret is a recognized intellectual

property right"; "In the United states, Section 757 of the First Restatement of Torts set forth six factors for evaluating the existence of a trade secret")

Martin/Applicant's admission doesn't teach, however Barney teaches:

- responsive to receipt of information comprising a first rating selected on a multipoint scale defining the extent that the information of the potential trade secret is known outside the business, a second rating selected on a multipoint scale defining the extent to which the information is known by employees and other involved in the business, a third rating selected on a multipoint scale defining the extent of measures taken by the business to guard the secrecy of the information, a fourth rating selected on a multipoint scale defining the extent of a value of the information to the business and the business competitors, a fifth rating selected on a multipoint scale defining an extent of the amount of money expended by the business in developing the information, and a sixth rating selected on a multipoint scale defining a relative ease or difficulty with which the information could be properly acquired or duplicated by others; associating the information corresponding to the first through sixth ratings with a identifier; storing the received first through sixth ratings in association with the identifier in a data storage device associated with the auditable accounting system using the digital processing device; and storing the calculated defendability metric in association with the trade secret identifier in the auditable accounting system using data storage device

associated with the digital processing device calculating, using the documentation tool and the digital processing device, a defendability metric for from the received first through sixth ratings;. (Barney: Fig. 11 – calculation; col. 5, lines 55-67 – assessing the defensibility of patent assets as well as intangible intellectual property assets; col. 7, line 30-col. 8, line 67 – statistical analysis is using metrics for scoring or rating based on individual characteristics. Identifying and quantifying the selected characteristics; cols. 11, 26 – one of the factors of the statistical based rating is defensibility; defensibility is rated on scale of 1-10; cols. 25, 28 – data stored on computer accessible memory device; searchable computer network database also used)

It would have been obvious to one of ordinary skill in the art to combine the teachings of Martin, Barney and Applicant's Admission. The intellectual property field has many branches two of which are patents and trade secrets. Valuation of IP would refer to valuation of both together or separately depending on the portfolio in question. Furthermore, the steps performed are typical of a computer with the ability to process and store information into a database. As a result, the use of a system for IP analysis that works for patents and notes other intangible assets would obviously be predictable to use for trademarks by one of ordinary skill in the art.

15.   **With respect to claims 125 and 129:** (currently amended) Martin teaches:

o   Comparing the calculated defendability metric for the trade secret identifier to a predetermined threshold value; Determining if the calculated

defendability metric exceeds the predetermined threshold value; (Martin:

col. 8, lines 5-45 – score can range from 1-100; "any score above 50

indicates that the intellectual property is transferable; col. 27, line 45-col.

28, line15 – different ranges calculated) and

Martin does not teach, however Applicant admits in the Background of the in

Invention that trade secret is a form of intellectual property. (Applicant's Admission:

Background of the Invention, pages 1 and 3 – "Trade secret is a recognized intellectual

property right"; "In the United states, Section 757 of the First Restatement of Torts set

forth six factors for evaluating the existence of a trade secret")

Martin/Applicant's admission doesn't teach, however Barney teaches:

  o   defining the trade secret identifier as relating to a defendable trade secret

       in the auditable accounting system. (Barney: cols. 11, 26 – one of the

       factors of the statistical based rating is defensibility; defensibility is rated

       on scale of 1-10)

It would have been obvious to one of ordinary skill in the art to combine the

teachings of Martin, Barney and Applicant's Admission. The intellectual property field

has many branches two of which are patents and trade secrets. Valuation of IP would

refer to valuation of both together or separately depending on the portfolio in question.

As a result, the use of a system for IP analysis that works for patents and notes other

intangible assets would obviously be predictable to use for trademarks by one of

ordinary skill in the art.

16.   **With respect to claims 126 and 130:** (currently amended) Martin teaches:

o   Repeating the acts of receiving, storing, calculating, and storing for

        information relating to a plurality of different trade secret identifiers;

        (Barney: Fig. 11 – calculation; col. 5, lines 55-67 – assessing the

        defensibility of patent assets as well as intangible intellectual property

        assets; col. 7, line 30-col. 8, line 67 – statistical analysis is using metrics

        for scoring or rating based on individual characteristics. Identifying and

        quantifying the selected characteristics; cols. 11, 26 – one of the factors of

        the statistical based rating is defensibility; defensibility is rated on scale of

        1-10; cols. 25, 28 – data stored on computer accessible memory device;

        searchable computer network database also used)

Martin does not teach, however Applicant admits in the Background of the in

Invention that trade secret is a form of intellectual property. (Applicant's Admission:

Background of the Invention, pages 1 and 3 – "Trade secret is a recognized intellectual

property right"; "In the United states, Section 757 of the First Restatement of Torts set

forth six factors for evaluating the existence of a trade secret")

Martin/Applicant's admission doesn't teach, however Barney teaches:

o   sorting, using the auditable accounting system, the plurality of different

        trade secret identifiers in increasing or decreasing numerical order of the

        calculated defendability metric, one of the first through sixth ratings, or the

        trade secret identifier. (Barney: Figs. 5-6; col. 12, lines 7-52; col. 28, lines

        5-50 – patents are ranked or rated)

It would have been obvious to one of ordinary skill in the art to combine the teachings of Martin, Barney and Applicant's Admission. The intellectual property field has many branches two of which are patents and trade secrets. Valuation of IP would refer to valuation of both together or separately depending on the portfolio in question. As a result, the use of a system for IP analysis that works for patents and notes other intangible assets would obviously be predictable to use for trademarks by one of ordinary skill in the art.

17.   **With respect to claims 127, 131 and 134:** (currently amended) Martin teaches the analysis of an IP portfolio and Applicant admission teaches that trade secret is an intangible asset in an IP portfolio. Martin/Applicant's admission does not teach, however Barney teaches:

- o   transmitting to a trade secret directory server, using a <u>communications device associated with the</u> digital <u>processor</u>, a request for a trade secret certificate corresponding to the <u>identifier relating to the defendable trade secret</u>; and receiving from the trade secret directory server, using <u>the communication device associated with the digital processor</u>, a generated certificate corresponding to the trade secret <u>identifier relating to the defendable</u>. (Barney: Fig. 11; col. 11 – report kept in portfolio; cols. 28-30 – rating report generated;)

It would have been obvious to one of ordinary skill in the art to combine the teachings of Martin, Barney and Applicant's Admission. The intellectual property field has many branches two of which are patents and trade secrets. Valuation of IP would

refer to valuation of both together or separately depending on the portfolio in question. As a result, the use of a system for IP analysis that works for patents and notes other intangible assets would obviously be predictable to use for trademarks by one of ordinary skill in the art.

18.   **With respect to claim 132:** (currently amended) Martin teaches the analysis of an IP portfolio and Applicant admission teaches that trade secret is an intangible asset in an IP portfolio.   Martin/Applicant's admission does not teach, however Barney teaches an accounting digital computer; a user interface device connected to the digital computer, the user interface device being configured to receive from a user inputs of ratings corresponding to a potential intellectual property; (Barney: col. 12 – computer model or computer algorithm used; col. 7, line 30-col. 8, line 67 – statistical analysis is using metrics for scoring or rating based on individual characteristics. Identifying and quantifying the selected characteristics; cols. 11, 26 – one of the factors of the statistical based rating is defensibility; defensibility is rated on scale of 1-10)

> o   a data storage device associated with the digital computer the data storage device having stored thereon, the computer-executable instructions being configured, upon execution by the digital computer, to perform the steps of receiving a first rating selected on a multipoint scale defining the extent that the information is known by employees and others involved in the business, receiving a third rating selected on a multipoint scale defining the extent of measures taken by the business to guard the secrecy of the information, receiving a fourth rating selected on a

multipoint scale defining the extent of a value of the information to the

business and the business's competitors, receiving a fifth rating selected

on a multipoint scale defining an extent of the amount of money expended

by the business in developing the information, and receiving a sixth rating

selected on a multipoint scale defining a relative ease or difficulty with

which the information could be properly acquired or duplicated by others,

the computer-executable instructions being further configured to perform

the steps of storing the received first through sixth ratings in the data

storage device, to calculate a trade secret defendability metric for the

potential trade secret from the received first through sixth ratings, and to

store the calculated trade secret defendability metric in the data storage

device; wherein the data storage device comprises a database in which

the first through sixth ratings and related data is stored. (Barney: Fig. 11 –

calculation; cols. 25, 28 – data stored on computer accessible memory

device; searchable computer network database also used; col. 7, line 15-

col. 8, line 67; col. 30, lines 25-45; cols. 25 and 26 – system to be used

with intellectual property assets; numeric and alphanumeric scores

assigned in rating assets; col. 5, lines 55-67 – assessing the defensibility

of patent assets as well as intangible intellectual property assets; col. 7,

line 30-col. 8, line 67 – statistical analysis is using metrics for scoring or

rating based on individual characteristics. Identifying and quantifying the

selected characteristics; cols. 11, 26 – one of the factors of the statistical

based rating is defensibility; defensibility is rated on scale of 1-10; probabilities calculated)

It would have been obvious to one of ordinary skill in the art to combine the teachings of Martin, Barney and Applicant's Admission. The intellectual property field has many branches two of which are patents and trade secrets. Valuation of IP would refer to valuation of both together or separately depending on the portfolio in question. As a result, the use of a system for IP analysis that works for patents and notes other intangible assets would obviously be predictable to use for trademarks by one of ordinary skill in the art.

19.   **With respect to claim 133:** (currently amended) Martin <u>comparing the calculated trade secret defendability metric for the potential trade secret to a predetermined threshold value; determining if the calculated trade secret defendability metric exceeds predetermined threshold value; identifying, in response to the act of determining, the potential trade secret as a defendable trade secret</u>. (Martin: col. 8, lines 5-45 – score can range from 1-100; "any score above 50 indicates that the intellectual property is transferable"; col. 10 - comparable)

20.   **With respect to claim 134:** (currently amended) Martin teaches the analysis of an IP portfolio and Applicant admission teaches that trade secret is an intangible asset in an IP portfolio. Martin/Applicant's admission does not teach, however Barney teaches <u>transmitting, via a communication device associated with the digital computer, to a intellectual property directory a request for a trade secret certificate corresponding to the determined defendable trade secret; and receiving, via communications</u>

processor of the digital computer, from the trade secret directory server a generated

certificate corresponding to the determined defendable trade secret. (Barney: Fig. 11 –

Rating report; col. 7-8 - internet used; information processed)

It would have been obvious to one of ordinary skill in the art to combine the

teachings of Martin, Barney and Applicant's Admission. The intellectual property field

has many branches two of which are patents and trade secrets. Valuation of IP would

refer to valuation of both together or separately depending on the portfolio in question.

As a result, the use of a system for IP analysis that works for patents and notes other

intangible assets would obviously be predictable to use for trademarks by one of

ordinary skill in the art.

21.   **With respect to claim 135: (New)** Martin teaches the analysis of an IP portfolio

and Applicant admission teaches that trade secret is an intangible asset in an IP

portfolio. Martin/Applicant's admission does not teach, however Barney teaches tool

and a user interface device configured to receive a respective rating of each of the first

through sixth ratings from a user. (Barney: Fig. 11 – calculation; cols. 25, 28 – data

stored on computer accessible memory device; searchable computer network database

also used; col. 7, line 15-col. 8, line 67; col. 30, lines 25-45; cols. 25 and 26 – system to

be used with intellectual property assets; numeric and alphanumeric scores assigned in

rating assets; col. 5, lines 55-67 – assessing the defensibility of patent assets as well as

intangible intellectual property assets; col. 7, line 30-col. 8, line 67 – statistical analysis

is using metrics for scoring or rating based on individual characteristics. Identifying and

quantifying the selected characteristics; cols. 11, 26 – one of the factors of the statistical

based rating is defensibility; defensibility is rated on scale of 1-10; probabilities

calculated)

It would have been obvious to one of ordinary skill in the art to combine the

teachings of Martin, Barney and Applicant's Admission. The intellectual property field

has many branches two of which are patents and trade secrets. Valuation of IP would

refer to valuation of both together or separately depending on the portfolio in question.

As a result, the use of a system for IP analysis that works for patents and notes other

intangible assets would obviously be predictable to use for trademarks by one of

ordinary skill in the art.

CONCLUSION

22.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Heidi Riviere whose telephone number is 571-270-1831.

The examiner can normally be reached on Monday-Friday 9:00am-5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. R./
Examiner, Art Unit 3689

/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689